UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/284,147 | 03/17/99 | LANQUETIN M | GEI-067 |

HM22/0211

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| EXAMINER | |
|---|---|
| QAZI,S | |
| **ART UNIT** | **PAPER NUMBER** |
| 1616 | 9 |

**DATE MAILED:** 02/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/284,147 | Lanquetin et al. |

| Examiner | Group Art Unit |
|---|---|
| Sabiha Qazi | 1616 |

☒ Responsive to communication(s) filed on *Dec 23, 1999* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) *21-33* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *21-33* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---*

## Final Action on Merits

## Status of the Application

All claims are canceled.

New claims 21-33 are added.

Claims 21-33 are pending.

Claims 21-33 are rejected.

Applicant's response in paper no. 7, dated 12/23/99 is hereby acknowledged. Amendments are entered.

## Rejection Withdrawn

The rejection under 112 (2) is withdrawn because claims are amended. The rejection under 102(b) over Sitruk-Ware (Accession number 96148040, MEDLINE, abstract of Rev. Prat, (1995), 45(19) pages 2401-2406) is withdrawn because applicant's arguments are found persuasive. Examiner is requesting for the translation of this reference from PTO library.

## Rejection Maintained

New claims 21-33 are rejected under 35 U.S.C. 103(a) as obvious over Conard et al. (Fertility and sterility, vol. 64 (4), (1995), pages 957-962) and 112 (1) rejection over claims 21-33 for no support in the specification for "conjugate equine

estrogen" and "estrogenic deficiencies". Note, that claim 1 is much more broader than the original claim and has no sufficient support.

**Response to Arguments**

Applicant's arguments filed on 12/23/99 are considered but are not found persuasive. Following reasons apply:

1. Applicant's argue that claims rejection over Conrad et al. should be withdrawn because estradiol and nomegesterol acetate is only administered for 14 consecutive days after which the amount of estradiol alone is given for 10 consecutive days and before the administration of placebo for the last 7 days whereas instant invention uses the combination of estradiol/progestrone in a continuous fashion for 21-25 days per month.

Examiner respectfully disagree because the estradiol/progestrone combination is taught by the prior art for the same use as is instantly claimed. The treatment by the same combination for extended days would have been obvious to one who is familiar with the art. Note, that the total days of treatment by the prior art is 24 days, 14 consecutive using combination and 10 using estradiol alone.

Applicants also argue that prior art teaches placebo whereas instant invention uses only the combination. Note, that placebo

is an inactive substance contains no medication and used for control.

Applicant's argue that "conjugated equine estrogen" are well known and referred to a journal article. Note, that journal article may not be descriptive, this instant application is for a US Patent which requires a complete support for what has been claimed, so there should be no undue burden to one having ordinary skilled in the art to practice the invention. Examiner could not find in specification any definition or how to get these compounds. The rejection therefore, is maintained.

New claims 21-33 are rejected under 35 U.S.C. 103(a) as obvious over Conard et al. (Fertility and sterility, vol. 64 (4), (1995), pages 957-962). (See the description under the heading "results" and "conclusion" on page 957; "results" on page 959; Tables 1 and 2 , page 959 and table 3 on page 960 and discussion on 960-961).

Conard et al. teaches the sequential combination of oral estrogen estradiol and nomegestrol acetate progestogen component 1.5 to 3.75 mg per unit dose. The treatments by the said estrogen-progestogen combinations are useful for treating ostrogen deficiency which significantly reduce menopausal

complaints. These combinations are also useful for preventing cardiovascular diseases.

The instant claims differ from the reference in having different generic scope. The instant invention is broader than the prior art by claiming the simultaneous administration of estrogenic and progestative compounds whereas prior art teaches estradiol and nomegestrol acetate. (Nomegestrol acetate is a 19-nor-progesterone derivative with potent progestational activity and no androgenicity).

One having ordinary skill in the art would be motivated to prepare additional beneficial composition and method known for the treatment of menopause complaints etc. the combination with a estrogen and a compound with progestational activity because prior art teaches that estradiol in combination with a progestative compound are useful for hormone replacement therapy, menopause complaints and for preventing cardiovascular diseases.

There has been ample motivation provided by the prior art to prepare such combination when searching for the compositions of the similar activity.

Claim 26 is drawn to estradiol valerate are known esters and property associated with the estradiol would be expected to estradiol unless any unexpected results are seen.

Claims 27, 30, 32 and 33 are drawn to the doses of the estrogen compound. The determination to employ the optimum ranges of the estrogen compound would have been within the skills of the one familiar with the art.

The data in the specification has been considered by the examiner. The results as shown were expected. Nothing unexpected is seen in the data provided in the specification.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

2. Claims 21-33 are rejected under 35 U.S.C. 103(a) as obvious over Fraser et al. (Medline, AN 89261206, abstract of Maturitas, (1989 Mar) 11(1), 21-34) and Cano et al. (CA 115:150824, abstract of Maturitas (1991), 13(1), 35-42). Both the references cited above individually teach the use of oral estradiol-progesterone combination. Cano teach estradiol-progesterone combination for cardiovascular diseases and discloses as good alternative in post-menopausal replacement therapy. Fraser teaches the effects of the addition of nomegestrol acetate to post menopausal teach addition of progestogen to the oestrogen in order to prevent endometrial abnormalities. See the abstracts.

The instant claims differ from the reference in having different generic scope. The instant invention is broader than the prior art by claiming the simultaneous administration of estrogenic and progestative compounds for estrogenic deficiencies.

One having ordinary skill in the art would have been motivated to prepare additional beneficial composition and method for the treatment of estrogenic deficiencies estradiol/progestrone for the treatment of post menopause estrogen deficiencies by using the combination with a estrogen and a compound with progestational activity because prior art teaches that estradiol in combination with a progestative compound for the treatment of estrogenic deficiencies.

There has been ample motivation provided by the prior art to prepare such combination when searching for the compositions of the similar activity.

Claim 26 is drawn to estradiol valerate are known esters and property associated with the estradiol would be expected to estradiol unless any unexpected results are seen.

Claims 27, 30, 32 and 33 are drawn to the doses of the estrogen compound. The determination to employ the optimum ranges of the estrogen compound would have been within the skills of the one familiar with the art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might

reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

3. Claims 21-33 are rejected under 35 U.S.C. 103(a) as obvious over Lanquetin et al. (US Patent 5,891,867). Lanquetin et al. teaches the method of treating estrogen deficiencies in menopausal women by the oral administration of an estrogen alone followed by the combination of estrogen progestogen combination and then a placebo. See the entire document especially lines 20-62, col. 1, lines 16-67, col. 2, cols 3 and 4, lines 10-64,

col. 5. These combination are useful for correction of estrogen deficiencies during natural or artificial menopause.

The instant claims differ from the reference in having different generic scope. The instant invention is broader than the prior art by claiming the simultaneous administration of estrogenic and progestative compounds for estrogenic deficiencies.

One having ordinary skill in the art would have been motivated to prepare additional beneficial composition and method for the treatment of estrogenic deficiencies during menopause. the combination with a estrogen and a compound with progestational activity because prior art teaches that estradiol in combination with a progestative compound for the treatment of estrogenic deficiencies.

There has been ample motivation provided by the prior art to prepare such combination when searching for the compositions of the similar activity.

Claim 26 is drawn to estradiol valerate are known esters and property associated with the estradiol would be expected to estradiol unless any unexpected results are seen.

Claims 27, 30, 32 and 33 are drawn to the doses of the estrogen compound. The determination to employ the optimum ranges of the estrogen compound would have been within the skills of the one familiar with the art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

## Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can

normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616